



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,936	06/08/2000	Steve Lemke	PALM-2849	1836

7590 11/24/2003

Wagner Murabito & Hao LLP  
Third Floor  
Two North Market Street  
San Jose, CA 95113

EXAMINER

ANDERSON, MATTHEW D

ART UNIT	PAPER NUMBER
----------	--------------

2186

DATE MAILED: 11/24/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/590,936

**Applicant(s)**

LEMKE, STEVE

**Examiner**

Matthew D. Anderson

**Art Unit**

2186

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

Art Unit: 2186

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 27-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 3.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 4, 6-7, 9, 14, 17, 19-20, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US Patent # 5,949,997).

4. With respect to claims 1 and 14, Smith discloses:

Art Unit: 2186

a processor (item 14); a first memory (20) coupled to the processor for storing information that is required during startup of the computer system; and a second memory (22) coupled to the processor, for storing new information and capable of retaining information stored therein upon restart of the computer system, as shown in figure 1;

an I/O device couple to the processor for receiving new information intended for the first memory deice from an external source, as taught by the communications port in column 2, lines 30-40;

restarting the computer system without relying on the new information, as shown in figure 3, item 62;

verifying said new information stored in the second memory to ensure that it is safe to load said new information into said first memory, and responsive to the verifying, loading the new information from the second memory into the fist memory wherein the new information can be used for a subsequent startup of the computer system, by teaching in the abstract of performing diagnostics to verify that the updated program is operational, and if so, the program is used for further initial boots.

5. With respect to claims 4 and 17, Smith discloses performing a checksum test of the new information in said second memory to ensure that said new information is free from corruption, as recited in column 2, line 54.

6. With respect to claims 6 and 19, Smith discloses the first memory comprising a flash ROM, as shown in figure 1, item 20.

Art Unit: 2186

7. With respect to claims 7 and 20, Smith discloses the new information comprising boot ROM code, by teaching in column 6, lines 55-60, that the microprocessor is booted using the stored program.

8. With respect to claims 9 and 22, Smith discloses the first memory having no information stored therein initially, because it would be inherent that at some point during manufacture that the memory would contain no information.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith.

11. With respect to claims 11 and 24, Smith discloses all other limitations, as discussed above, while stating in column 2, lines 35-40, that the second program is received into the system through some type of communications port, but does not specifically disclose that the new information is received wirelessly. Since the specific use of a wireless connection does not have a disclosed purpose nor are disclosed to overcome any deficiencies in the prior art, the connection described above may have been embodied in a number of manners. Accordingly, it would have been an obvious matter to one skilled in the art to utilize the communications port of Smith, as disclosed supra, since applicant has not disclosed that a wireless connection, as opposed to other connections, overcomes a deficiency in the prior art or is for any stated purpose.

12. Claims 2, 8, 10, 15, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Tamori *et al.* (US Patent # 5,960,445).

13. With respect to claims 2 and 15, Smith discloses all other limitations, as discussed above, but does not specifically disclose the step of copying existing information in the first memory to the second memory such that the existing information can be restored into the first memory should the first memory become corrupted. Tamori *et al.* teach in figure 10 of copying the current BIOS to the external RAM.

14. With respect to claims 8 and 21, Smith discloses all other limitations, as discussed above, but does not specifically disclose the new information comprising operation system code.

Tamori *et al.* teach in column 5, lines 30-31, of the BIOS code being control programs in the OS.

15. With respect to claims 10 and 23, Smith discloses all other limitations, as discussed above, but does not specifically disclose the second memory being a RAM. Tamori *et al.* teach this in figure 10-18.

16. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith and Tamori *et al.* before him at the time the invention was made, to modify the boot program update taught by Smith, to include the copying of existing version to external storage, OS code, and RAM, as with the boot program update of Tamori *et al.*, in order to provide failure recovery during the boot program update process, as taught by Tamori *et al.*.

17. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Hill *et al.* (US Patent # 5,987,605).

Art Unit: 2186

18. With respect to claims 3 and 16, Smith discloses all other limitations, as discussed above, but does not specifically disclose checking the version date of the new information in the second memory to ensure compatibility. Hill *et al.* teach in column 7, lines 42-46, of using version information to determine if the boot memory devices are inconsistent.

19. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith and Hill *et al.* before him at the time the invention was made, to modify the boot program update taught by Smith, to include the version checking, as with the boot program update of Hill *et al.*, in order to assure consistency, as taught by Hill *et al.*.

20. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Lim (US Patent # 6,138,233).

21. With respect to claims 5 and 18, Smith discloses all other limitations, as discussed above, but does not specifically disclose checking a power level to ensure the loading can be completed without power failure. Lim teach in column 4, lines 20-23, of updating the BIOS only when the battery level exceeds a certain threshold.

22. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith and Lim before him at the time the invention was made, to modify the boot program update taught by Smith, to include the power level checking, as with the boot program update of Lim, in order to assure update completion, as taught by Lim.

23. Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith and Pierre-Louis *et al.* (US Patent # 6,421,777).

Art Unit: 2186

24. With respect to claims 12 and 25, Smith discloses all other limitations, as discussed above, but does not specifically disclose the computer system being a PDA. Pierre-Louis *et al.* teach in column 5, line 3, of the client system being a PDA.

25. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith and Pierre-Louis *et al.* before him at the time the invention was made, to modify the boot program update taught by Smith, to include a PDA client, as with the boot program update of Pierre-Louis *et al.*, in order to provide handheld computing, as taught by Pierre-Louis *et al.*.

26. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Pierre-Louis *et al.*, and Theimer *et al.* (US Patent # 6,421,777).

27. With respect to claims 13 and 26, Smith discloses all other limitations, as discussed above, while Pierre-Louis *et al.* teach such a boot program update system in a PDA, but does not specifically disclose the external source being a PDA. Theimer *et al.* teach in column 5, line 3, of transferring files between PDAs.

28. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith, Pierre-Louis *et al.*, and Theimer *et al.* before him at the time the invention was made, to modify the boot program update in a PDA taught by Smith and Pierre-Louis *et al.*, to have the update boot program file be transferred via another PDA as in Theimer *et al.*, in order to provide multicomputer handheld communication, as taught by Theimer *et al.*.



Art Unit: 2186

*Conclusion*

29. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar boot program update systems.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Anderson whose telephone number is (703) 306-5931. The examiner can normally be reached on Monday-Friday, 2nd Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (703) 305-3821. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Matthew D. Anderson', with a long horizontal flourish extending to the right.

Matthew D. Anderson  
November 20, 2003